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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT PAPER NUMBER

2176

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,112

Applicant(s)

ERICSON ET AL.

Examiner

Doug Hutton

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-30 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20020329.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Prosecution Reopened

In view of the Appeal Brief filed on 9 May 2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 15:

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine

which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 15 recites a "*computer-readable medium* having embodied thereon a computer program." In the Specification of the present invention, this "medium" includes "propagated signals" and "carrier waves" (see Specification – Paragraph 0089). Neither of these mediums is "tangible" or "concrete." Thus, Claim 15 recites an invention that is not tangibly-embodied on a computer-readable medium.

Applicant may obviate this rejection by amending the claim to — A computer program tangibly embodied on a computer-readable medium which can be read by a computer and comprises instructions for causing a computer to execute the method according to Claim 1 or 2. —.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-12, 15-17 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Lazzouni et al., U.S. Patent No. 5,652,412.

Claim 1:

Lazzouni discloses a method of editing a document (see Column 1, Lines 6-8; see Column 2, Lines 28-31 – Lazzouni discloses this limitation in that the information recording system allows a user to edit a document by recording written information on encoded paper and recording the written information in computer memory), the method comprising:

- transferring document information to a printing device adapted to print the document information on a surface having a position-coding pattern (see Column 4, Lines 8-14; see Column 4, Lines 43-50; see Column 14, Lines 16-33 – Lazzouni discloses this limitation in that the information recording system includes paper encoded with pixels. The encoded paper is used by sales/mobile personnel to record “business transactions” in “sales books” and can be “made as a **form**” (emphasis added), as indicated in Column 4, Lines 43-50. Also, other forms can be used with the system, as indicated in Column 14, Lines 16-33.);
- receiving editing information from a reading device adapted to read position information from the surface (see Figures 1-3; see Column 2, Line 60 through Column 3, Line 8; see Column 4, Lines 15-42; see Column 5, Line 20 through Column 6, Line 45 – Lazzouni discloses this limitation in that the information recording system includes a pen and a recording apparatus. The pen allows the user to write on the encoded paper. When the user writes on the encoded paper, the components within the pen (see Figure 3) read the pixels on the encoded paper to digitally record the user’s handwriting by detecting the location of the

- pen with respect to the pixels, as indicated in Column 5, Line 20 through Column 6, Line 45. The "pen location" data is then sent to the recording apparatus.);
- interpreting the editing information (see Figure 7; see Column 2, Line 60 through Column 3, Line 8; see Column 4, Lines 15-42; see Column 8, Line 65 through Column 9, Line 13 – Lazzouni discloses this limitation in that the information recording system includes the pen and the recording apparatus, wherein the recording apparatus includes components (see Figure 7) that "decode," "synthesize" and "compress" the data received from the pen, as indicated in Column 8, Line 65 through Column 9, Line 13. The data is then stored in a microprocessor.); and
 - changing the document information depending on an interpretation of the editing information, thereby resulting in an updated document (see Column 9, Line 25-27; see Column 14, Lines 22-33 – Lazzouni discloses this limitation in that the information recording system provides both a hardcopy and a digital copy of the form and the user's handwriting, as indicated in Column 14, Lines 22-33. The digital copy may then be printed by a host computer, as indicated in Column 9, Line 25-27.).

Claim 2:

Lazzouni discloses a method of editing a document (as indicated in the above rejection for Claim 1, Lazzouni discloses this limitation), the method comprising:

- transferring position-coding pattern information to a printing device adapted to print the position-coding pattern on a surface (see Figure 4; see Column 8, Lines 22-37 – Lazzouni discloses this limitation in that the information recording system comprises printing pattern of pixels on paper);
- transferring document information to the printing device adapted to print the document information on a surface having a position-coding pattern (see Column 4, Lines 8-14; see Column 4, Lines 43-50; see Column 14, Lines 16-33 – Lazzouni discloses this limitation in that the information recording system includes paper encoded with pixels. The encoded paper is used by sales/mobile personnel to record “business transactions” in “sales books” and can be “made as a **form**” (emphasis added), as indicated in Column 4, Lines 43-50. Also, other forms can be used with the system, as indicated in Column 14, Lines 16-33.);
- receiving editing information from a reading device adapted to read position information from the surface (as indicated in the above rejection for Claim 1, Lazzouni discloses this limitation);
- interpreting the editing information (as indicated in the above rejection for Claim 1, Lazzouni discloses this limitation); and
- changing the document information depending on an interpretation of the editing information, thereby resulting in an updated document (see Column 9, Line 25-27; see Column 14, Lines 22-33 – Lazzouni discloses this limitation in that the information recording system provides both a hardcopy and a digital copy of the form and the user’s handwriting, as indicated in Column 14, Lines 22-33. The

digital copy may then be printed by a host computer, as indicated in Column 9, Line 25-27.).

Claim 6:

Lazzouni discloses the method according to Claim 1 or 2, wherein the editing information includes position information related to a position of the reading device on the surface (see Figures 1-3; see Column 2, Line 60 through Column 3, Line 8; see Column 4, Lines 15-42; see Column 5, Line 20 through Column 6, Line 45 – Lazzouni discloses this limitation in that the pen allows the user to write on the encoded paper. As the user writes on the encoded paper, the components within the pen (see Figure 3) read the pixels on the encoded paper to digitally record the user's handwriting by detecting the location of the pen with respect to the pixels, as indicated in Column 5, Line 20 through Column 6, Line 45. The "pen location" data is then sent to the recording apparatus.), and wherein the interpretation of the editing information includes interpretation of the position information (see Figure 7; see Column 2, Line 60 through Column 3, Line 8; see Column 4, Lines 15-42; see Column 8, Line 65 through Column 9, Line 13 – Lazzouni discloses this limitation in that the recording apparatus includes components (see Figure 7) that "decode," "synthesize" and "compress" the data received from the pen, as indicated in Column 8, Line 65 through Column 9, Line 13. The data is then stored in a microprocessor.).

Claim 7:

Lazzouni discloses the method according to Claim 6, wherein the position information is in the form of sequences of coordinates forming manually generated curves corresponding in form to drawn curves on the printed document (As indicated in the above rejections for Claims 1, 2 and 6, the pen and the recording apparatus detect and record the pen locations as the user edits the document. As the user edits the document, the user forms "manually generated curves" in that the user's handwriting includes curved lines. The "sequences of coordinates" of the user's handwriting are detected and recorded by the pen and the recording apparatus as the user edits the document.).

Claim 8:

Lazzouni discloses the method according to Claim 1 or 2, further comprising displaying the document information of the updated document to a user (see Column 9, Line 25-27; see Column 14, Lines 22-33 – Lazzouni discloses this limitation in that the information recording system provides both a hardcopy and a digital copy of the form and the user's handwriting, as indicated in Column 14, Lines 22-33. The digital copy may then be printed by a host computer, as indicated in Column 9, Line 25-27.).

Claim 9:

Lazzouni discloses the method according to Claim 1 or 2, wherein the step of changing the document information includes adding editing information in the form of

handwritten annotations to the document (As indicated in the above rejections for Claims 1 and 2, the information recording system allows the user to make handwritten annotations to the document).

Claim 10:

Lazzouni discloses the method according to Claim 9, further comprising associating, based on position information included in the editing information, each of the handwritten annotations with a respective portion of the document information (see Figures 1-3; see Column 2, Line 60 through Column 3, Line 8; see Column 4, Lines 15-42; see Column 5, Line 20 through Column 6, Line 45; see Column 9, Line 25-27; see Column 14, Lines 22-33 – Lazzouni discloses this limitation in that the components within the pen (see Figure 3) read the pixels on the encoded paper to digitally record the user's handwriting by detecting the location of the pen with respect to the pixels as the user writes on the encoded paper. Thereafter, the information recording system provides both a hardcopy and a digital copy of the form and the user's handwritten annotations, as indicated in Column 14, Lines 22-33. Thus, the user's annotations are "associated with a respective portion of the document information.").

Claim 11:

Lazzouni discloses the method according to Claim 1 or 2, wherein changing the document information includes reformatting one or more parts of the document information (see Column 9, Line 25-27; see Column 14, Lines 22-33 – Lazzouni

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discloses this limitation in that the information recording system incorporates the user's handwriting into the form and provides both a hardcopy and a digital copy of the form and the user's handwriting, as indicated in Column 14, Lines 22-33. The digital copy may then be printed by a host computer, as indicated in Column 9, Line 25-27.).

Claim 12:

Lazzouni discloses the method according to Claim 11, wherein said reformatting is chosen from the group of:

- adding text or graphics to said document information (see Column 9, Line 25-27; see Column 14, Lines 22-33 – Lazzouni discloses this limitation in that the information recording system incorporates the user's handwriting into the form and provides both a hardcopy and a digital copy of the form and the user's handwriting, as indicated in Column 14, Lines 22-33. The digital copy may then be printed by a host computer, as indicated in Column 9, Line 25-27.); removing text or graphics from said document information; or repositioning text or graphics included in said document information.

Claim 15:

Claim 15 merely recites computer software that performs the method of Claims 1 or 2. The system disclosed in Lazzouni operates on a computer. Accordingly, Lazzouni discloses every limitation of Claim 15, as specified in the above rejections for Claims 1 and 2.

Claim 16:

Lazzouni discloses a system for document editing (see Column 1, Lines 6-8; see Column 2, Lines 28-31 – Lazzouni discloses this limitation in that the information recording system allows a user to edit a document by recording written information on encoded paper and recording the written information in computer memory), the system comprising:

- storage means for storing a document (see Column 1, Line 11 through Column 2, Line 17; see Column 9, Lines 14-38 – Lazzouni discloses this limitation in that it discloses many prior art devices that are used to edit documents stored in a “storage means.” Additionally, the information recording system comprises a host computer that can store all documents manipulated within the system. Finally, the recording apparatus comprises a storage means for storing the user’s handwritten edits to the form.);
- means for transferring information from the document to a printing device capable of printing the information on a surface provided with a position-coding pattern (as indicated in the above rejections for Claims 1 and 2, Lazzouni discloses this limitation);
- means for receiving editing information from a reading device adapted to read position information from a position-coded surface (as indicated in the above rejection for Claim 1, Lazzouni discloses this limitation);
- means for interpreting the editing information (as indicated in the above rejection for Claim 1, Lazzouni discloses this limitation); and

- means for changing the document information based on an interpretation of the editing information, thereby resulting in an updated document (as indicated in the above rejection for Claim 2, Lazzouni discloses this limitation).

Claim 17:

Lazzouni discloses a system for document editing (as indicated in the above rejection for Claim 16, Lazzouni discloses this limitation), the system comprising:

- storage means for storing a document (as indicated in the above rejection for Claim 16, Lazzouni discloses this limitation);
- means for transferring position-coding pattern information to a printing device capable of printing the position-coding pattern on a surface (as indicated in the above rejection for Claim 2, Lazzouni discloses this limitation);
- means for transferring information contained in the document to the printing device, the printing device being adapted to print the information on the surface (as indicated in the above rejection for Claim 1, Lazzouni discloses this limitation);
- means for receiving editing information from a reading device adapted to read position information from a position-coded surface (as indicated in the above rejection for Claim 1, Lazzouni discloses this limitation);
- means for interpreting the editing information (as indicated in the above rejection for Claim 1, Lazzouni discloses this limitation); and

- means for changing the document information based on an interpretation of the editing information, thereby resulting in an updated document (as indicated in the above rejection for Claim 2, Lazzouni discloses this limitation).

Claim 22:

Lazzouni discloses a method of editing a document containing information (see Column 1, Lines 6-8; see Column 2, Lines 28-31 – Lazzouni discloses this limitation in that the information recording system allows a user to edit a document by recording written information on encoded paper and recording the written information in computer memory. As indicated in the above rejection for Claim 1, the edited documents include forms.), the system comprising:

- storing the document document information in memory (see Column 1, Line 11 through Column 2, Line 17; see Column 9, Lines 14-38 – Lazzouni discloses this limitation in that it discloses many prior art devices that are used to edit documents stored in memory. Additionally, the information recording system comprises a host computer that can store all documents manipulated within the system. Finally, the recording apparatus comprises memory for storing the user's handwritten edits to the form.);
- printing the document information on a surface, wherein the surface contains a readable code contained thereon in addition to the printed document information (see Column 4, Lines 8-14; see Column 4, Lines 43-50; see Column 14, Lines 16-33 – Lazzouni discloses this limitation in that the information recording system

includes paper encoded with pixels. The encoded paper is used by sales/mobile personnel to record “business transactions” in “sales books” and can be “made as a **form**” (emphasis added), as indicated in Column 4, Lines 43-50. Also, other forms can be used with the system, as indicated in Column 14, Lines 16-33.);

- enabling an electronic pen to physically mark edit instructions on the surface and to electronically capture the edit instructions by reading the readable code proximate the marked edit instructions (see Figures 1-3; see Column 2, Line 60 through Column 3, Line 8; see Column 4, Lines 15-42; see Column 5, Line 20 through Column 6, Line 45 – Lazzouni discloses this limitation in that the information recording system includes a pen and a recording apparatus. The pen allows the user to write on the encoded paper. When the user writes on the encoded paper, the components within the pen (see Figure 3) read the pixels on the encoded paper to digitally record the user’s handwriting by detecting the location of the pen with respect to the pixels, as indicated in Column 5, Line 20 through Column 6, Line 45. The user’s handwriting comprises “edit instructions” in that it modifies and revises the form.);
- receiving through a processor associated with the memory the edit instructions captured by the electronic pen (see Figures 1-3; see Column 2, Line 60 through Column 3, Line 8; see Column 4, Lines 15-42; see Column 5, Line 20 through Column 6, Line 45 – Lazzouni discloses this limitation in that the “pen location” data is sent to the recording apparatus.); and

- altering the document information in memory to conform to the edit instructions (see Column 9, Line 25-27; see Column 14, Lines 22-33 – Lazzouni discloses this limitation in that the information recording system provides both a hardcopy and a digital copy of the form and the user's handwriting, as indicated in Column 14, Lines 22-33. The digital copy may then be printed by a host computer, as indicated in Column 9, Line 25-27.).

Claim 23:

Lazzouni discloses the method of Claim 22, wherein the readable code is a position coding pattern (see Column 4, Lines 8-14 – Lazzouni discloses this limitation in that the information recording system includes paper encoded with pixels).

Claim 24:

Lazzouni discloses the method of Claim 1, wherein the position-coding pattern codes a plurality of positions on the surface, each position being coded by a plurality of symbols, wherein each symbol contributes to the coding of more than one of the plurality of positions (see Figures 4-6; see Column 6, Line 35 through Column 8, Line 21 – Lazzouni discloses this limitation in that the information recording system includes paper encoded with pixels extending over the entire surface of the paper, wherein the pixels define unique coordinate positions on the surface of the paper.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni, in view of Henderson, U.S. Patent No. 5,897,648.

Claim 3:

As indicated in the above rejections, Lazzouni discloses every element of Claim 1 or 2.

Lazzouni fails to expressly disclose receiving device identity information from the reading device, the identity information associating the editing information with a user of the reading device.

Henderson teaches a method of editing a document (see Column 1, Lines 8-11 – Henderson teaches this limitation in that the electronic document editing system edits electronic documents), the method comprising receiving device identity information from a reading device, the identity information associating editing information with a user of the reading device (see Figures 2-3; see Column 5, Lines 6-34; see Column 7, Lines 11-26 – Henderson teaches these limitations in that the electronic document editing system includes multiple digitizer pens having different pen colors. The different pen colors are used to indicate edits made by different persons.), for the purpose of

separately identifying the edits made by various individuals (see Column 7, Lines 24-26).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Lazzouni, to include receiving device identity information from the reading device, the identity information associating the editing information with a user of the reading device, for the purpose of separately identifying the edits made by various individuals, as taught in Henderson.

Claim 4:

As indicated in the above rejections, Lazzouni discloses every element of Claim 1 or 2.

Lazzouni fails to expressly disclose editing information that is associated with a plurality of users, and wherein each user generates at least one editing command with a reading device.

Henderson teaches a method of editing a document (see Column 1, Lines 8-11 – Henderson teaches this limitation in that the electronic document editing system edits electronic documents), the method comprising receiving editing information that is associated with a plurality of users, and wherein each user generates at least one editing command with a reading device (see Figures 2-3; see Column 5, Lines 6-34; see Column 7, Lines 11-26 – Henderson teaches these limitations in that the electronic document editing system includes multiple editors working on a common document, each editor having a digitizer pen that has a different pen color. The different pen colors

are used to indicate edits made by different persons. The edits made by the editors are "editing commands" in that the edits indicate changes to be made to the document.

This teaching implies that each editor is capable of "generating at least one editing command."), for the purposes of allowing multiple editors to edit a common document and separately identifying the edits made by various individuals (see Column 7, Lines 24-26).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Lazzouni, to include editing information that is associated with a plurality of users, and wherein each user generates at least one editing command with a reading device, for the purposes of allowing multiple editors to edit a common document and separately identifying the edits made by various individuals, as taught in Henderson.

Claim 18:

Claim 18 merely recites a computer system that performs the method of Claim 3. Accordingly, Lazzouni, in view of Henderson, discloses/teaches every limitation of Claim 18, as specified in the above rejection for Claim 3.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni, in view of Skinner, U.S. Patent No. 6,661,920.

Claim 13:

As indicated in the above rejection, Lazzouni discloses every element of Claim 12.

Lazzouni fails to expressly disclose that the "adding text" step includes converting part of the editing information to machine-readable text.

Skinner teaches a computer device that allows a user to write words and letters onto a digitizer pad using a pen. The device then converts the user's handwriting into machine-readable format. Thus, Skinner teaches converting handwriting into machine-readable text for the purpose of allowing a user to input data into the computer device (see Column 1, Lines 54-65).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Lazzouni, to include converting part of the editing information to machine-readable text into the "adding text" step, for the purpose of allowing a user to input data into the computer device, as taught in Skinner.

Claims 14, 19-21 and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable Lazzouni, in view of Dymetman et al., U.S. Patent Application Publication No. US 2002/0020750 A1.

Claim 14:

As indicated in the above discussion, Lazzouni discloses every element of Claims 1 or 2. Lazzouni also discloses initially registering said document in a pattern administration unit, wherein said pattern administration unit assigns a unique subset of said position-coding pattern (see Figures 4 and 5; see Column 6, Line 35 through Column 8, Line 21 – Lazzouni discloses these limitations in that the information recording system records a pattern of pixels for each document. The patterns for each document are unique in that each pattern is established by a coding algorithm that includes the following factors: number of different inks used, number of shades (or, intensity levels), number of data lines in each pixel, width of each line; dimensions of each pixel, size of the paper, and the number of pixels in an x and y directions. The system stores each of these different patterns when they are created.).

Lazzouni fails to expressly disclose a pattern administration unit that assigns a unique subset of said position-coding pattern *to each page of said document*.

Dymetman teaches a method of manipulating a document (see Figures 3-7; see Paragraphs 0013-0017 – Dymetman teaches this limitation in that the document editing system identifies actions to be taken with corresponding documents), the method comprising:

- a pattern administration unit that assigns a unique subset of said position-coding pattern to each page of said document (see Figures 3-7; see Paragraphs 0013-0017 – Dymetman teaches this limitation in that the document editing system

uses dataglyphs to identify particular pages and to specify a function to be performed regarding that particular page),
for the purpose of specifically identifying a particular page and indicating a function to be performed regarding that particular page (see Paragraphs 0013-0017).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Lazzouni, to include a pattern administration unit that assigns a unique subset of said position-coding pattern to each page of said document, for the purpose of specifically identifying a particular page and indicating a function to be performed regarding that particular page, as taught in Dymetman.

Claim 19:

Claim 19 merely recites a computer system that performs the method of Claim 14. Accordingly, Lazzouni, in view of Dymetman, discloses/teaches every limitation of the claim as specified in the above rejection for Claim 14.

Claim 20:

Lazzouni discloses a means for receiving editing information that is included in a pattern administration unit (As indicated in the above rejection for Claim 14, the information recording system disclosed in Lazzouni includes a "pattern administration unit." As indicated in the above rejection for Claim 1, the information recording system

disclosed in Lazzouni includes a “means for receiving editing information.” Thus, Lazzouni discloses this limitation.).

Claim 21:

Lazzouni discloses a means for receiving editing information that is included in a local processing unit (As indicated in the above rejection for Claim 1, the information recording system disclosed in Lazzouni includes a pen and a recording apparatus. Thus, Lazzouni discloses this limitation.).

Claim 25:

As indicated in the above discussion, Lazzouni, in view of Dymetman, discloses/teaches every element of Claim 14. Lazzouni also discloses a pattern administration unit that, in the registering, receives document data indicative of the document (As indicated in the above rejection for Claim 1, Lazzouni discloses this limitation in that the information recording system allows the user to print a form on paper having a prerecorded pattern of pixels. The form is “document data” that is “indicative of the document.”).

Lazzouni fails to expressly disclose a pattern administration unit that, in the registering, receives document data indicative of the document *and of a number of document pages*.

Dymetman teaches a method of manipulating a document (as indicated in the above rejection for Claim 14, Dymetman teaches this limitation), the method comprising:

- a pattern administration unit that, in the registering, receives document data indicative of the document (see Paragraphs 0013-0017 – Dymetman teaches this limitation in that the document editing system uses dataglyphs to identify documents) and of a number of document pages (see Paragraphs 0007 and 0016 – Dymetman teaches this limitation in that the document editing system includes page identifiers. Also, the disclosure indicates that the prior art includes paper pixels that include page numbers.),

for the purpose of specifically identifying particular documents and pages within a document (see Paragraphs 0013-0017).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Lazzouni, to include:

- a pattern administration unit that, in the registering, receives document data indicative of the document and of a number of document pages,

for the purpose of specifically identifying particular documents and pages within a document, as taught in Dymetman.

Claim 26:

Lazzouni discloses document data that includes the document (As indicated in the above rejection for Claim 1, Lazzouni discloses this limitation in that the information recording system allows the user to print a form on paper having a prerecorded pattern of pixels. The form is “document data” that “includes the document.”).

Claim 27:

As indicated in the above discussion, Lazzouni discloses every element of Claim 16. Lazzouni also discloses registration means which is arranged to initially register the document in a pattern administration unit comprising a database of the position-coding pattern, the pattern administration unit being arranged to assign a unique subset of the position-coding pattern (see Figures 4 and 5; see Column 6, Line 35 through Column 8, Line 21 – Lazzouni discloses these limitations in that the information recording system records a pattern of pixels for each document. The patterns for each document are unique in that each pattern is established by a coding algorithm that includes the following factors: number of different inks used, number of shades (or, intensity levels), number of data lines in each pixel, width of each line; dimensions of each pixel, size of the paper, and the number of pixels in an x and y directions. The system stores each of these different patterns when they are created.).

Lazzouni fails to expressly disclose a pattern administration unit that assigns a unique subset of the position-coding pattern *to each page of the document*.

Dymetman teaches a system for manipulating a document (see Figures 3-7; see Paragraphs 0013-0017 – Dymetman teaches this limitation in that the document editing system identifies actions to be taken with corresponding documents), the system comprising:

- a pattern administration unit that assigns a unique subset of said position-coding pattern to each page of the document (see Figures 3-7; see Paragraphs 0013-0017 – Dymetman teaches this limitation in that the document editing system

uses dataglyphs to identify particular pages and to specify a function to be performed regarding that particular page),
for the purpose of specifically identifying a particular page and indicating a function to be performed regarding that particular page (see Paragraphs 0013-0017).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in Lazzouni, to include a pattern administration unit that assigns a unique subset of the position-coding pattern to each page of the document, for the purpose of specifically identifying a particular page and indicating a function to be performed regarding that particular page, as taught in Dymetman.

Claim 28:

Lazzouni discloses storage means and registration means that are included in a computer device (see Figure 7).

Claim 29:

As indicated in the above discussion, Lazzouni, and further in view of Dymetman, discloses/teaches every element of Claim 27. Lazzouni also discloses a registration means that is arranged to transfer document data indicative of the document to the pattern administration unit (see Figures 4 and 5; see Column 6, Line 35 through Column 8, Line 21 – Lazzouni discloses these limitations in that the information recording system records a pattern of pixels for each document. The patterns for each document

are unique in that each pattern is established by a coding algorithm that includes the following factors: number of different inks used, number of shades (or, intensity levels), number of data lines in each pixel, width of each line; dimensions of each pixel, size of the paper, and the number of pixels in an x and y directions. The system stores each of these different patterns when they are created. As indicated in the above rejection for Claim 1, Lazzouni discloses that the information recording system allows the user to print a form on paper having a prerecorded pattern of pixels. The form is "document data" that is "indicative of the document.").

Lazzouni fails to expressly disclose a registration means that is arranged to transfer document data indicative of the document *and of a number of document pages* to the pattern administration unit.

Dymetman teaches a system for manipulating a document (as indicated in the above rejection for Claim 27, Dymetman discloses this limitation), the method comprising:

- a registration means that is arranged to transfer document data indicative of the document (see Paragraphs 0013-0017 – Dymetman teaches this limitation in that the document editing system uses dataglyphs to identify documents) and of a number of document pages to the pattern administration unit (see Paragraphs 0007 and 0016 – Dymetman teaches this limitation in that the document editing system includes page identifiers. Also, the disclosure indicates that the prior art includes paper pixels that include page numbers.),

for the purpose of specifically identifying particular documents and pages within a document (see Paragraphs 0013-0017).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in Lazzouni, to include:

- a registration means that is arranged to transfer document data indicative of the document and of a number of document pages to the pattern administration unit, for the purpose of specifically identifying particular documents and pages within a document, as taught in Dymetman.

Claim 30:

Lazzouni discloses document data that includes the document (As indicated in the above rejection for Claim 1, Lazzouni discloses this limitation in that the information recording system allows the user to print a form on paper having a prerecorded pattern of pixels. The form is "document data" that "includes the document.").

Allowable Subject Matter

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 5:

The closest prior art is Lazzouni et al., U.S. Patent No. 5,652,412, Henderson, U.S. Patent No. 5,897,648, and Merritt et al., U.S. Patent No. 6,041,335. The disclosure of Lazzouni and the teachings of Henderson are discussed at length in the above rejections.

Merritt teaches a collaborative system that allows multiple users to add annotations to a document. A timestamp is attached to each annotation so that the annotations can be ordered sequentially.

However, the system in Merritt does not include a surface having position-coding pattern. Rather, the system provides a window in a graphical user interface that allows a user to add annotations to a document. Thus, there is no motivation to combine the teachings of Merritt with the disclosure of Lazzouni and the teachings of Henderson.

Accordingly, the prior art fails to disclose or suggest edits generated by a plurality of users, wherein the edits are received on a surface having a position-coded surface, wherein the edits are in an ordered sequence identified by a timestamp associated with each editing command, as recited in Claim 5.

Response to Arguments

Applicant's arguments with respect to Claims 1-4, 6-13, 15-18 and 22-24 have been considered but are moot in view of the new ground(s) of rejection. However, the

examiner will respond to two points made by Applicant with regard to Lazzouni for the purpose of forwarding prosecution of the case.

Applicant argues that the examiner failed to provide any support for his assertion that Lazzouni discloses allowing a user to print a form on paper having a prerecorded pattern of pixels. See *Appeal Brief* – Page 11, third paragraph.

The examiner disagrees.

The examiner did provide support for this assertion in the Final Rejection on Page 3, final paragraph (Column 4, Lines 8-14; Column 4, Lines 43-50; and Column 14, Lines 16-33). Also, the above rejections provide support for this assertion.

Applicant argues that there is no discussion in Lazzouni that is directed to editing documents. See *Appeal Brief* – Page 13, second full paragraph.

The examiner disagrees.

The form disclosed in Lazzouni is “edited” in that it is filled in and written upon by the user. To “edit” a document is to revise or modify the document in some way. By writing upon the form, the user “edits” the form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
July 14, 2005

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized flourish at the end.

**DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100**